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[REDACTED] EXAMINER

YUN, EUGENE

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| ART UNIT | PAPER NUMBER |
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2682
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Please find below and/or attached an Office communication concerning this application or proceeding.

(1)

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|------------------------------|-----------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/595,114 | KIMURA ET AL. | |
| Examiner | | Art Unit | |
| Eugene Yun | | 2682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3-5 and 12-37 is/are pending in the application.
 - 4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 3-5 and 12-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 June 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|---|--|
| <ol style="list-style-type: none"> 1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | <ol style="list-style-type: none"> 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____. |
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DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 36 and 37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Independent Claim 36 is more directed to billing and providing specific discounts to employee benefits.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 36 and 37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 30-34 is rejected under 35 U.S.C. 102(b) as being anticipated by Valentino (US 4,468,037).

Referring to Claim 30, Valentino teaches a system for providing benefits from at least one of a plurality of benefits vendors to at least one benefits recipient, the system comprising:

at least one computer network connecting a benefits provider server system storing information of a first type 24 and 26 (fig. 4), a benefits coordinator server system (see col. lines 33-38), and a plurality of benefits vendor server systems storing information of a second type (see col. 10, lines 22-24 where the IBM mainframe computer is the vendor system);

 said benefits coordinator server system including a portal accessible by said at least one benefits recipient 24 and 26 (fig. 4);

 said benefits coordinator server system programmed to select information of said second type obtained from at least one of said plurality of vendor server systems, the selection based upon information of said first type obtained from said benefit provider server system, said benefits coordinator server system providing said information of said second type to said benefits recipient via said portal (see col. 2, lines 4-27).

 Referring to Claim 31, Valentino also teaches said information of said first type selected from the group comprising non traditional benefits information (see col. 7, lines 5-18) and said information of said second type selected from the group comprising employee data stored on said benefits provider computer system (see col. 7, lines 35-42).

 Referring to Claim 32, Valentino also teaches said benefits coordinator server system further programmed to select information of said second type from at least one of said plurality of vendor server systems based, at least in part upon information of a third type provided by a benefits recipient (see col. 7, lines 43-50).

Referring to Claim 33, Valentino also teaches said information of a third type selected from the group comprising: information relating to personal interests of said benefits recipient, information relating to professional interests of said benefits recipient, information relating to life events of said benefits recipient, and information relating to family members of said benefits recipient (see col. 8, lines 66-68 and col. 9, lines 1-15).

Referring to Claim 34, Valentino also teaches said non traditional benefits selected from a group comprising:

Investment providers, health benefits providers, retirement benefits providers, exercise benefits providers, travel benefits providers, food benefits providers, child care benefits providers, housing benefits providers, and discount goods and services benefits providers (see col. 14, lines 2-18) and wherein said employee data is selected from the group comprising: gender, age, birthdate, length of employment, dependent information, health information (see col. 7, lines 35-42).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 12-18, 21, 24, 25, 27-29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino (US 4,648,037) in view of Hoffer (US 5,799,151).

Referring to Claim 12, Valentino teaches a system for providing benefits information to at least one benefits recipient comprising:

at least one portal 24 and 26 (fig. 4);

at least one benefits coordinator computer system communicating with said portal (see col. 4, lines 33-38);

at least one benefits recipient system communicating with said portal 20 (fig. 4);

at least one benefits vendor computer system communicating with said benefits coordinator computer system such that benefits information is provided from at least one of said benefits vendor computer systems to said benefits recipient system (see col. 10, lines 22-24 where the IBM mainframe computer is the vendor system);

wherein said benefits coordinator computer system selects vendor information from at least one of said vendor systems for delivery to said benefits recipient based, at least in part upon information stored on said benefits coordinator computer system (see col. 2, lines 4-27).

Valentino does not teach a portal web site which is communicated with via the Internet. Hoffer teaches a portal web site which is communicated with via the Internet (see col. 5, lines 5-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claim 21, Valentino teaches system for delivering benefits information to at least one benefits recipient, the system comprising:

a benefits provider computer system storing employee information 24 and 26 (fig. 4);

a benefits coordinator computer system storing further employee information provided by said benefits recipient (see col. 4, lines 33-38);

a benefits vendor computer system storing vendor benefits information in communication with said benefits coordinator computer system (see col. 10, lines 22-24 where the IBM mainframe computer is the vendor system);

said benefits coordinator computer system including a server providing a portal accessible by said benefits recipient, said server programmed such that benefits information provided to said benefits recipient via said portal is selected from said stored vendor benefits information based, at least in part, upon said information stored by said benefits provider computer system via said portal to said benefits recipient (see col. 2, lines 4-27).

Valentino does not teach a portal web site which is communicated with via the Internet. Hoffer teaches a portal web site which is communicated with via the Internet (see col. 5, lines 5-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claim 24, Valentino teaches a method of providing benefits information from an employer to at least one employee benefits recipient, the method comprising the steps of:

providing a computer network connecting an employer server system 24 and 26 (fig. 4), a benefits coordinator server system (see col. lines 33-38), and a plurality of benefits vendor server systems (see col. 10, lines 22-24 where the IBM mainframe computer is the vendor system);

providing a portal on said coordinator server system, said portal accessible by said at least one employee benefits recipient 24 and 26 (fig. 4);

providing selected vendor benefits information from at least one of said plurality of benefits vendors to said employee benefits recipient via said portal, said vendor benefits information selected based on information stored on said employer server system (see col. 2, lines 4-27).

Valentino does not teach a portal web site. Hoffer teaches a portal web site (see col. 5, lines 5-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claim 13, Valentino also teaches said information stored on said benefits coordinator computer system selected from the group comprising: gender, age, address, personal interests, professional interests, employment information (see col. 7, lines 35-42).

Referring to Claim 5, 14, and 27, Valentino also teaches said at least one benefits vendor is selected from a group comprising:

Investment providers, health benefits providers, retirement benefits providers, exercise benefits providers, travel benefits providers, food benefits providers, child care benefits providers, housing benefits providers, and discount goods and services benefits providers (see col. 14, lines 2-18).

Referring to Claims 15, Valentino also teaches at least one benefits provider computer system communicating with said benefits coordinator computer system 26 (fig. 4).

Referring to Claim 16, Valentino also teaches said benefits coordinator computer system programmed to select vendor information from said vendor computer system for delivery to said benefits recipient based, at least in part, upon information received by said benefits coordinator computer system from said benefits provider computer system (see col. 2, lines 4-27).

Referring to Claim 17, Valentino also teaches a server included in said benefits coordinator computer system and said benefits vendors computer systems and said benefits recipients computers systems are client system in communication with said client server system (see fig. 4).

Referring to Claim 18, Valentino also teaches a thin client system (fig. 4).

Referring to Claim 25, Valentino teaches obtaining personal data from said employee benefits recipient via said portal, selecting benefits information from the at least one of said plurality of vendor servers based on the personal data obtained by carrying out the obtaining step, and providing the selected vendor benefits information to said employee benefits recipient via said portal (see col. 2, lines 4-27).

Valentino does not teach a portal web site. Hoffer teaches a portal web site (see col. 5, lines 5-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

Referring to Claim 28, Valentino also teaches providing at least one vendor benefit at a reduced cost based on the number of said employee benefits recipients selectable to receive said at least one vendor benefit (see col. 15, lines 14-26).

Referring to Claim 29, Valentino also teaches offering at least one discount on vendor benefits such that the costs of administering said benefits from said employer to said employee benefits recipient by said benefits coordinator is reduced (see col. 15, lines 14-26).

Referring to Claim 35, Valentino does not teach said computer network including the Internet. Hoffer teaches said computer network including the Internet (see col. 5, lines 5-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Hoffer to said system of Valentino in order to provide easier access from employees to personal information and employee benefits.

6. Claims 3, 4, 19, 20, 22, 23, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentino and Hoffer in view of Dahm et al. (US 6,466,783).

Referring to Claim 3, 19, 20, 22, 23, and 26, Valentino teaches said benefits as employment related benefits (see ABSTRACT). The combination of Valentino and Hoffer does not teach said benefits accessible to the benefits recipients through a wireless PDA. Dahm teaches said benefits accessible to the benefits recipients through a wireless PDA (see col. 2, lines 3-9 noting that access to the WWW by said PDA as shown in fig. 2A enables the user to access employee related benefits). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Dahm to said system of Valentino in order to better provide access to employee related benefits regardless of location.

Referring to Claim 4, Dahm also teaches said PDA displaying web pages according to the WAP standard (see 264 of fig. 2B).

Response to Arguments

7. Applicant's arguments with respect to claims 3-5 and 12-35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eugene Yun whose telephone number is (703) 305-2689. The examiner can normally be reached on 8:30am-5:30pm Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Eugene Yun
Examiner
Art Unit 2682

EY


CHARLES APPIAH
PRIMARY EXAMINER